

## **REMARKS**

Applicant thanks the Examiner for indicating that the claim objection and rejection under 35 U.S.C. § 112, ¶ 1 has been withdrawn. Applicant also thanks the Examiner for advising that Attachments A and B to the Medvinsky declaration were not received. Applicant has provided the attachments with this response, along with another copy of the Medvinsky declaration and a color copy of Attachment A for the Examiner's convenience.

### **I. Introduction**

Claims 1-7 and 10-23 are pending in the above application.

Claims 1, 17 and 19 stand rejected under 35 U.S.C. § 112 ¶ 1.

Claims 1-7 and 10-23 stand rejected under 35 U.S.C. § 103.

Claims 1, 6, 13, 17 and 19 are independent claims.

### **II. Prior Art Rejections**

Claims 1-3, 6-7, 10-16 and 19-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Klingler et al. (U.S. Pub. No. 2003/0003896) in view of Dent (U.S. Pat. No. 5,081,679).

Claims 4 and 5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Klingler in view of Dent and in view of Crichton et al. (U.S. Pub. No. 2002/0031126).

Claims 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Klingler in view of Crichton in view of Dent.

As explained in Applicant's previous response, Klingler was filed on December 19, 2001 and claims priority to provisional application 60/256,668 filed on December 19, 2000. The above application was filed on January 16, 2001, prior to the filing date of Klingler but after the filing date of Klingler's provisional application. Accordingly, Klingler only qualifies as prior art to the above application by reliance on its provisional filing date and only under 35 U.S.C. § 102(e).

While Applicant does not concede that Klingler is supported by its provisional, the attached § 1.131 declaration of Alexander Medvinsky, establishes that the invention of the above application was conceived prior to the filing date of the Klingler provisional, i.e., prior to December 19, 2000. Particularly, the attached declaration establishes that the subject matter of the claimed invention of the above application was submitted to the law department of General Instrument Corporation by September 19, 2000. Accordingly, the attached declaration antedates Klingler and removes Klingler as prior art. See, MPEP 715.

The Examiner kindly pointed out that the Attachments to the Medvinsky declaration were not received, and hence, the Examiner had only the statements in the declaration itself to consider. As best understood, the Examiner advised that only the statements in the declaration itself are insufficient evidence for establishing conception of the invention. The missing attachments are provided with this response, and are believed to address the Examiner's concerns.

Particularly, Attachment A to the Medvinsky declaration is titled "Invention Record Form" and dated by Mr. Medvinsky on September 12, 2000 and also bears a stamp date by the General Instrument Corporation Law Department of September 19,

2000. See, Attachment A, upper right hand corner for the Law Department stamp. Applicant has also provided a color copy of Attachment A (Invention Disclosure Form) for the Examiner, which may be easier to read. Mr. Medvinsky explains that the stamp date indicates the date of receipt of the Invention Record Form by the law department of General Instrument Corporation.

As illustrated in Attachment B, Mr. Medvinsky's invention was approved for filing as a patent application and sent to Charles J. Kulas, Esq. of the law firm Townsend Townsend & Crew in a letter dated October 10, 2000. The application was then filed four months later on January 16, 2001.

Also provided with this response is a declaration from Mr. Charles J. Kulas which explains that outside counsel maintained a docket of cases to be drafted which effectively constituted a backlog of unrelated cases diligently prepared the application in accordance with standard practices for attorney diligence. See, MPEP, 2138.06 "Reasonable Diligence" and "Diligence Required In Preparing And Filing Patent Application." Particularly, the declaration of Mr. Kulas states

5. To the best of my recollection I, including Townsend and Townsend and Crew, LLP, maintained a docket of cases to be drafted which effectively constituted a backlog of unrelated cases. In the standard practice of myself and Townsend and Townsend and Crew, LLP, cases in the backlog were taken up in chronological order and prepared expeditiously.

Accordingly, as the primary reference, Klingler, has been antedated and is no longer prior art, Klingler also cannot be used in a rejection under 35 U.S.C. § 103. Accordingly, Applicant respectfully requests the above rejection under Klingler in view of Dent to be withdrawn. Furthermore, Applicant respectfully requests the above rejection under Klingler in view of Dent and Crichton to be withdrawn.

B. Applicants again note that all of the above rejections rely on Klingler as § 102(e) prior art to the above application. Crichton is also relied on as § 102(e) prior art. However, neither Klingler nor Crichton clearly qualify as 102(e) prior art. Klingler was filed on December 19, 2001 as U.S. Serial No. 10/028,573 and claims priority to U.S. Provisional application 60/256,668 filed on December 19, 2000. The filing date of Klingler (December 19, 2001) is after the filing date of the above application (January 16, 2001) and the Office action appears to rely on the provisional filing date of Klingler. Likewise, Crichton was filed on September 12, 2001 as U.S. Serial No. 09/953,317 (after the filing date of the above application) and claims priority to provisional application 60/232,094 filed on September 12, 2000. Applicant respectfully traverses relying on the provisional filing dates of Klingler and Crichton, especially since the utility applications of Klingler and Crichton contain substantially more disclosure including more figures and description, than their provisionals. Since utility applications may and often do contain additional subject matter not disclosed in the provisional, there is simply no logic nor legal foundation for blindly relying a provisional filing date as the 102(e) date of a reference.

Neither Klingler nor Crichton have been established to be prior art to Applicant's invention. The Rejection simply relies on the provisional filing dates without attempt to justify such reliance. This practice is contrary to the current examination guidelines set forth in the MPEP. See MPEP § 706.02(f)(1) Examination Guidelines for Applying References Under 35 U.S.C. 102(e), (B), which states as follows:

Determine if the potential reference resulted from, or claimed the benefit of, an international application. If the reference does, go to step (C) below. *The 35*

*U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph.* See MPEP § 2136.02.

Respectfully, the burden is on the Examiner to establish an entitlement to rely on the provisional filing date in the rejection.

Moreover, Klingler's provisional application does not "support the subject matter used to make the rejection in compliance with 35 U.S.C. § 112, first paragraph" in order to rely on the provisional filing date for the rejection. It is not clear if any of the "citations" in Klingler upon which the Examiner relies are disclosed in the Klingler provisional. For example, the Examiner cites paragraph [0026] of Klingler as allegedly containing a "synchronization counter with a size of a message that allows determining when the last block of the message has been transmitted as the counter decrements to zero then initializing the cryptosystem," which is apparently construed to relate to Applicant's claimed voice packets. Office action, pg. 5. This feature does not appear to be contained in the provisional, i.e. the provisional does not discuss packets and the provisional does not discuss instructing a counter to count to zero to initialize a cryptosystem.

The Examiner kindly responds by attempting to point out support in the Klingler provisional. However, as the Examiner is unable to describe the alleged support without referencing the Klingler patent application, the Examiner has merely established that the provisional clearly does not support such. For example, the Examiner alleges:

In addition the diagram describes a determination is made to find out if the master encryption switch is on and the number bytes of the message (i.e. size) to be

transmitted are loaded into the counter to start the encryption synchronization process (see figure 14 and paragraphs 94-95). Figure 14, 1401 further shows the synchronization of the decrement synchronization counter with respect to the encryption synch counter: determining if the encryption synch counter is started, if the master encryption switch is on as well as information about the message and decrementing the counter by one; if the encryption synch counter is zero, a new key is generated and the encryption is considered synch, the encryption synch counter stops (see paragraph 98 and figure 14).

Office action, pg. 2. However, far from establishing support in the Klingler provisional, the Examiner directs Applicant to the Klingler patent application for support of the relied upon subject matter, i.e. paragraphs 94-95 and 98 are in the patent application, not the provisional. Such a bootstrapping type of argument clearly does not establish that the provisional provides the requisite support for justification to rely on the filing date of the provisional.

Moreover, the Examiner makes not attempt to establish the use of packets in the Klingler provisional.

At best, the Examiner has established that the Klingler provisional appears to share a common drawing with the Klingler patent application, but the Examiner relies on the Klingler patent application for more than what is illustrated in common drawing. However, the Examiner has not established that all that is relied upon in the Klingler patent application is supported by the Klingler provisional, and indeed seems to establish that the relied upon subject matter is not supported by as shown by the inability to identify such elements in the provisional alone, without reference to the Klingler patent application.

Accordingly, it is clear that the provisional simply does not provide the requisite support to rely on its filing date to reject applicant's claims.



### **III. Conclusion**

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby requests such extension and the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

Respectfully submitted,

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